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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,534	01/16/2004	Teruyuki Motohashi	DP-985 US	5610
21254	7590	11/01/2006	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			RAMAKRISHNAIAH, MELUR	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
10/758,534	MOTOHASHI, TERUYUKI	
Examiner	Art Unit	
Melur Ramakrishnaiah	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1-16-04/4-28-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-4, 5-10, 11-16 are rejected under 35 U.S.C 102(e) as being anticipated by Chang (US2002/0122605A1).

Regarding claim 1, Chang discloses a mobile videophone terminal for performing video communication using a still image or moving image, comprising: an image capturing section (10, fig. 1) for capturing a first display information, a videophone communication performing section for receiving second display from a receiving end in the video communications to perform videophone communication, a data communication performing section (20, fig. 1) for retrieving third display information through a predetermined base station (not shown, note: background images can be downloaded from the internet: paragraph: 0022), an image combining section (reads on 34, fig. 1) for generating fourth display information by combining at least two selected from the first to third display information, a transmitting image selecting section for inputting therein to fourth display information to select and transmit at least one of the display information as a transmitting image to the receiving end, and displaying image

selecting section for selecting and displaying one of the first to fourth display information as displaying image (paragraphs: 0014 –0029; figs. 1-3).

Regarding claims 3-4, 5-10, 11-16, Chang further teaches the following: a memory (50, fig. 1) for storing fifth display information, wherein the image combining section (34, fig. 1) further uses fifth display information to generate the fourth display information, the transmitting selecting section inputs therein the fifth display information to select and transmit at least one of the display information as a transmitting image to the receiving end, and the displaying image selecting section selects and displays one of the first to fifth display information as displaying image, the first to fifth display information includes a still image, a moving image, and/or text information, while the video communication is being performed, the third display information is obtained through data communication (such as internet: paragraph: 0022) and transmitted as a transmitting image to the receiving end, the third display information obtained through data communication during the video communication is combined with the first display information that is being captured by the transmitting mobile videophone terminal as a transmitting image to the receiving end (paragraphs: 0014 –0029; figs. 1-3).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 17-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Kim (WO2003/005717A1).

Chang differs from claim 2 in that it does not specifically teach a multi-access communication performing section for simultaneously activating videophone communication performing section and data communication performing section.

However, Kim discloses visual mode mobile phone and visual mode telephoning method using same which teaches the following: a multi-access communication performing section for simultaneously activating videophone communication performing section and data communication performing section (page 11 lines 18-21).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Chang's system to provide for the following: a multi-access communication performing section for simultaneously activating videophone communication performing section and data communication performing section as this arrangement would facilitate obtaining information from external source and transmitting to receiving videophone as taught by Kim, thus sharing information with other users.

Chang differs from claims 17-20 in that although he teaches the following: while the video communication is being performed, the third display information is obtained through data connection (such as internet) and transmitted as transmitting image to the receiving end (paragraphs: 0019-0022), he does not teach the following: the fifth display information that has been stored in the mobile videophone terminal is transmitted as a transmitting image to the receiving end.

However, Kim teaches the following: the display information that has been stored in the mobile videophone terminal is transmitted as a transmitting image to the receiving end (page 6, line 7 – page 8, line 20).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Chang's system to provide for the following: the fifth display information that has been stored in the mobile videophone terminal is transmitted as a transmitting image to the receiving end as this arrangement would facilitate to transmit stored picture when he does not desire to transmit camera picture as taught by Kim, thus facilitating user convenience.

Chang differs from claims 21-24 in that although he teaches the following: the third display information obtained through data communication during the video communication is combined with the first display information that are being captured by transmitting mobile videophone terminal, and transmitted as a transmitting image to the receiving end (paragraphs: 0022-0026), he does not teach the following: the fifth display information that has been stored in the mobile videophone terminal is transmitted as a transmitting image to the receiving end.

However, Kim teaches the following: the display information that has been stored in the mobile videophone terminal is transmitted as a transmitting image to the receiving end (page 6, line 7 – page 8, line 20).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Chang's system to provide for the following: the fifth display information that has been stored in the mobile videophone terminal is

transmitted as a transmitting image to the receiving end as this arrangement would facilitate to transmit stored picture when he does not desire to transmit camera picture as taught by Kim, thus facilitating user convenience.

Chang differs from claims 25-28 in that although he teaches the following: the fifth display information that has been stored in the mobile videophone terminal is combined with the first display information that is being captured by the transmitting mobile videophone terminal, and transmitted as transmitting image to the receiving end (paragraphs: 0022-0026), he does not specifically teach the following: while the video communication is being performed, the third display information is obtained through data communication and transmitted as a transmitting image to the receiving end.

However, Kim teaches the following: while the video communication is being performed, the display information is obtained through data communication and transmitted as a transmitting image to the receiving end (page 11, pages 18-21).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Chang's system to provide for the following: while the video communication is being performed, the third display information is obtained through data communication and transmitted as a transmitting image to the receiving end as this arrangement would facilitate the user to transmit various information to the others during videophone communication as taught by Kim.

Regarding claims 29-32, Chang teaches the following: the third display information obtained through data communication (such as internet) during video communication is combined with the first display information that are being captured by

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the transmitting mobile videophone terminal, and transmitted as a transmitting image to the receiving end, and/or the fifth display information that has been stored in the mobile videophone terminal is combined with the first display information that is being captured by the transmitting mobile videophone terminal, and transmitted as a transmitting image to the receiving end (paragraphs: 0014 –0029; figs. 1-3).

Chang differs from claims 33-36 in that although he teaches the following: while the video communications is being performed, the third display information is obtained through data communication (such as internet) and transmitted as a transmitting image to the receiving end (paragraphs: 0022-0026), he does not specifically teach the following: the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information.

However, Kim teaches the following: the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information (fig. 3, page 6, line 7 – page 8, line 20).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Chang's system to provide for the following: the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information as this arrangement would provide flexibility for user in transmitting images to the other party as taught by Kim, thus contributing to user convenience.

Chang differs from claims 37-40 in that although he teaches the following: the third display information obtained through data communication (such as internet) during

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video communication is combined with the first display information that are being captured by the transmitting mobile videophone terminal, and transmitted as a transmitting image to the receiving end (paragraphs: 0022-0026), he does not teach the following: the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information.

However, Kim teaches the following: the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information (fig. 3, page 6, line 7 – page 8, line 20).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Chang's system to provide for the following: the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information as this arrangement would provide flexibility for user in transmitting images to the other party as taught by Kim, thus contributing to user convenience.

Chang differs from claims 41-44 in that he does not specifically teach the following: the fifth display information that has been stored in the mobile videophone is transmitted as a transmitting image to the receiving end, the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information.

However, Kim teaches the following: the display information that has been stored in the mobile videophone is transmitted as a transmitting image to the receiving end, the

mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information (fig. 3, page 6, line 7 – page 8, line 20).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Chang's system to provide for the following: the fifth display information that has been stored in the mobile videophone is transmitted as a transmitting image to the receiving end, the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information as this arrangement would provide flexibility for user in transmitting images to the other party as taught by Kim, thus contributing to user convenience.

Chang differs from claims 45-48 in that although he teaches the following: fifth display information that has been stored in the mobile videophone terminal is combined with the first display information that are being captured by the transmitting mobile videophone terminal, and transmitted as a transmitting image to the receiving end (paragraphs: 0022 – 0026), he does not teach the following: the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information.

However, Kim teaches the following: the display information that has been stored in the mobile videophone is transmitted as a transmitting image to the receiving end, the mobile videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information (fig. 3, page 6, line 7 – page 8, line 20).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Chang's system to provide for the following: the mobile

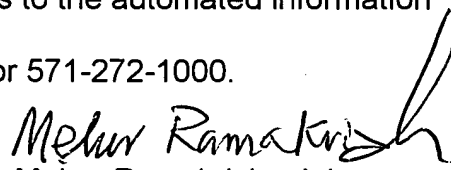
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videophone terminal further includes a function of arbitrarily determining whether or not to transmit the third display information as this arrangement would provide flexibility for user in transmitting images to the other party as taught by Kim, thus contributing to user convenience.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614